



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE GOUGH ET AL.

Application for Patent

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Examiner Pham, Khanh B. Art Unit 2166

**METHOD AND APPARATUS FOR
THE PRODUCTION, DELIVERY AND RECEIPT OF ENHANCED E-MAIL**

APPEAL BRIEF

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I. REAL PARTY IN INTEREST

The real party in interest is G&H Nevada-Tek.

09/01/2009 MGE BREM1 00000061-09997322

01 FC:2402 270.00-0P

09/01/2009 MGE BREM1 00000061-09997322

02 FC:2251 65.00-0P

II. RELATED APPEALS AND INTERFERENCES

This appeal may be related to one or more of the following appeals to the USPTO Board of Patent Appeals and Interferences (BPAI):

<u>Docket Number</u>	<u>Serial Number</u>	<u>Filing Date</u>
NEO1P020.US01	09/400,712	09/21/1999
NEO1P029.US01	09/493,468	01/28/2000
NEO1P036.US01	09/721,552	11/22/2000

The BPAI has not rendered any opinions with respect to the above identified appeals.

III. STATUS OF CLAIMS

Claims 1, 33-51, 61-65 and 84-84 stand rejected.

IV. STATUS OF AMENDMENTS

There has been no amendment after the final rejection and all amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter defined in each of the independent claim involved in the appeal under the provisions of 37 CFR 41.37(c)(1)(v). This concise explanation in no way limits what Applicant understands to be the claimed invention in its various embodiments. Rather, the concise explanation provides examples of embodiments in the specification and drawings that are made by way of example, not limitation. Citations to like elements may not be repeated herein.

In an example embodiment as set forth in independent claim 1, a method for providing an audiovisual e-mail system includes: providing a server connected to a network (Fig. 1, page 7, lines 4-5); inputting a message and an audiovisual enhancement which is associated with the message from a sender into the server (Fig. 3, page 11, lines 20-31), the message to be sent as an e-mail to at least one recipient on the network (Fig. 1, page 7, lines 4-5); associating the message with a self-executing, network downloadable programmable enhancement operative to automatically stream the audiovisual enhancement, at least in part, from the server over the network upon the opening of the e-mail (Fig. 4, page 12, line 18 to page 14, line 2) and to display the audiovisual enhancement within the e-mail in conjunction with the message without the requirement of a previously installed viewer; and sending the e-mail over the network to the at least one recipient (Fig. 1, page 7, lines 4-5).

In an example embodiment as set forth in independent claim 40, computer program segments embodied in computer readable media to provide an audiovisual e-mail system including: a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender (Fig. 1, page 7, lines 4-5, Fig. 12, page 20, line 29 to page 21, line 6), the message to be sent as an e-mail to at least one recipient on the network (Fig. 1, page 7, lines 4-5); and a code segment associating the message with a self-executing, network downloadable code segment (Fig. 4, page 12, lines 18-22) operative to automatically stream the audiovisual enhancement, at least in part, from the server over the network and to display the audiovisual enhancement within the e-mail in conjunction with the message upon the

selection of the message by the at least one recipient without the requirement of a previously installed viewer (Fig. 1, page 7, lines 4-5).

In an example embodiment as set forth in independent claim 46, an audiovisual e-mail system includes means transmitting over a network to a server from a sender machine (Fig. 1, page 7, lines 4-5) an audiovisual enhancement which is associated with a message from the sender, the message to be sent as an e-mail to at least one recipient on the network; and means associating (Fig. 4, page 12, lines 18-22) the message with a self-executing program operative to stream the audiovisual enhancement, at least in part, from the server over the network and to display the audiovisual enhancement in conjunction with the message on a recipient machine upon the selection of the message by the at least one recipient.

In an example embodiment as set forth in independent claim 61, a method for providing active e-mail including: generating a sender e-mail including a code segment in the e-mail to cause a self-executing, transient code segment (Fig. 4, page 12, line 18 to page 14, line 2) to automatically download over a network and execute within a context of the e-mail upon an opening of the e-mail; and sending the e-mail to a recipient.

In an example embodiment as set forth in independent claim 62, an e-mail server includes a computer (Fig. 1, page 7, lines 4-5) configured to receive e-mail text from a sender, to associate the e-mail text with a code segment and to send the code segment to a recipient in a body of an e-mail (Fig. 4, page 12, line 18 to page 14, line 2).

In an example embodiment as set forth in independent claim 63, a computer program embodied on computer-readable media for providing active e-mail includes: software segments receiving e-mail text from a sender; software segments associating the e-mail text with a code segment (Fig. 4, page 12, line 18 to page 14, line 2); and software segments sending the code segment to a recipient in a body of an e-mail.

In an example embodiment as set forth in independent claim 64, a method for providing e-mail includes: providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on the recipient computer (Fig. 4, page 12, line 18 to page 14, line 2); and streaming the audio and/or video file (Fig. 12, page 21, lines 5-6) to the recipient computer for display within the open e-mail in such a manner that other content of the e-mail which is intended to be viewed is not visually obscured (Fig. 12; also page 14, line 30 code for wrapping

text around objects).

In an example embodiment as set forth in independent claim 65, a computer program embodied on computer-readable media for providing e-mail includes: software segments providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on the recipient computer (Fig. 4, page 12, lines 18-22); and software segments streaming (Fig. 12, page 21, lines 5-6) the audio and/or video file to the recipient computer for display within the open e-mail in such a manner that other content of the e-mail which is intended to be viewed is not visually obscured.

In an example embodiment as set forth in independent claim 84, a method for enhancing an e-mail including: enhancing an e-mail with an HTML code segment (Fig. 4, page 12, line 18 to page 14, line 2); and reviewing the enhancement of the e-mail by executing the HTML code segment (Fig. 2, page 9, lines 9-10) prior to sending the e-mail.

In an example embodiment as set forth in independent claim 85, an e-mail server including a computer configured to enhance an e-mail with an HTML code segment (Fig. 4, page 12, lines 18-22) and to permit the review the enhancement of the e-mail by executing the HTML code segment (Fig. 2, page 9, lines 9-10) prior to sending the e-mail.

In an example embodiment as set forth in independent claim 86, a computer program embodied on computer-readable media for enhancing an e-mail includes: software segments for enhancing an e-mail with an HTML code segment (Fig. 4, page 12, line 18 to page 14, line 2); and software segments for reviewing the enhancement of the e-mail by executing the HTML code segment (Fig. 2, page 9, lines 9-10) prior to sending the e-mail.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The rejection under 35 U.S.C. 102(b) of claims 46-51 and 61-65 as being anticipated by XP-002150023 ("Streaming Email")
- B. The rejection under 35 U.S.C. 102(e) of claims 84-86 as being anticipated by U.S. Patent No. 6,223,213 of Cleron et al.
- C. The rejection under 35 U.S.C. 103(a) of claims 1 and 33-45 as being unpatentable over XP-002150023 ("Streaming Email") in view of Tolba et al. ("Pure Java-based Streaming MPEG Player")

VII. ARGUMENT

For the reasons set forth below, Appellants contends that the rejections of the claims should be reversed.

- A. The rejections under 35 U.S.C. 102(b) of claims 46-51 and 61-65 as being anticipated by XP-002150023 ("Streaming Email") are in error and should be reversed.

The Examiner has not made a *prima facie* case of anticipation with this rejection. It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). As noted below, the Streaming Email does not show each element of the independent claims, let alone the dependent claims.

1. Claim 46

Independent claim 46 has been reproduced below:

**46. An audiovisual e-mail system comprising:
means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender, said message to be sent as an e-mail to at least one recipient on said network; and
means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient.**

The Examiner rejects this claim as anticipated by Streaming Email by referring to pages 310-313 which are reproduced below:

multimedia file to use—that's it. Follow these steps for a more in-depth, step-by-step procedure.

1. First, when you first start Video Express Email, you have to go through some routine setup questions like your name and email address and your Internet connection speed. Then you're sent to the main screen, which looks like a blank email message.
2. To send a Video Express Email message, simply enter in the recipient's email address and type in your message and subject like you normally would. Next comes the multimedia portion. You can choose to send an audio, video, or slide show. You can record them on the spot or choose an existing file from your hard drive.
3. If you want to record and send video, press the Video button, and a new capture window will appear. Select your video compression (Video Express Email recommends you pick Full Frames, Uncompressed format for best quality), then wait for your local window to appear (see Figure 18.4). From there, you can start recording by pressing the red Record button, or change your options under the Options menu selection, like your window size or color controls.
4. After you record your message, select File/Exit and you will jump back to the main Video Express Email screen. The video you just recorded should

Figure 18.4 The capture window appears, and the local video window is shown so you can begin recording your video greeting.



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will stop. As the message is being sent, you'll see a scrolling message saying "Transfer in Progress" running across the window. You'll receive notification when the message transmission is completed.

Some options to consider before sending a message include attaching the player to the message in case the recipient doesn't have it. Just check off the corresponding box at the bottom of the window. Next to that is the Allow Download checkbox. Enabling that option means that the recipient can also download the actual message as well as stream it. That is a good option for when the recipient would like to have a better quality, perhaps uncompressed, video file.

To send messages faster, don't send the Video Express Email player or the actual downloadable multimedia file. These seriously slow down your transmission, especially with large files. Only send downloadable files if your recipient absolutely needs a copy for offline viewing.

Choosing the Create Multimedia Slide Show button opens up Microsoft's ASF Editor program. This program allows you to create your own multimedia slide shows that include audio, still pictures, and script commands. (For more on NetShow and the ASF Editor, see Chapter 10, "Microsoft NetShow: The Future of Streaming Media.")

Receiving Video Express Email Messages

When you receive Video Express Email, you get your message the same way as you receive your other emails: Use your regular email program to check your messages. You will get the Video Express Email along with the small text file attachment. Unless you chose to send the player and/or allow downloading, email retrieval from your host will be very fast.

Your email message may look something like Figure 18.5. It includes the Video Express Email player that will allow you to view and stream the file.

If you haven't already done so, click on the file called SETUP.EXE to install the Video Express Email player. Once that's done, it is installed for good and you need not install it again unless you uninstall it later.

The last step is the easiest. Most email programs like Netscape Mail and Eudora allow you to double-click on the message to launch it with its specified player. Double-click on it and the Video Express Email miniplayer should launch and play the message (see Figure 18.6). If you're having trouble receiving the

appear in the Media File section, along with its path and filename. Remember, you can also send audio or existing multimedia images in the same way. You can also send slide shows created for NetShow.

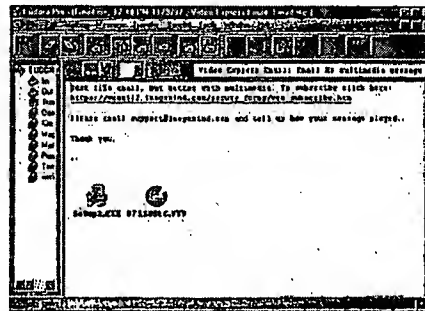
5. If this is the first Video Express Email message that your recipient will receive, he or she will need to download and install the Video Express Email Player. Check the box that reads "Include VEMail Player" to attach a copy of the player along with the rest of the message. Optionally, your recipient can visit Image Mind's website to download the player, which will need to be installed once per computer.
6. It is a good idea to preview the multimedia file before sending it. After you've finished recording or selecting your outgoing multimedia file, preview it by pressing the Preview Message button. You will be asked to choose a bandwidth speed that you want to compress it to. Then press OK to begin watching the preview for that bandwidth. You can always change your compression and bandwidth selection before sending the message. To change your codec options, go back to the main menu and choose File/Preferences. From there, open up the Audio Transport Rate Preferences screen to change codecs and audio options, like lowering the sample rate, switching to mono or stereo, and so forth.
7. Once you've previewed the file, you can press the Send button to send your message. You will be asked if you want to change your compression and bandwidth settings before you continue. If you are happy with the existing configuration that you chose during preview, leave it or is and continue sending the file; otherwise, select a new bandwidth. You can choose from 14.4Kbps all the way to T1 speeds. Once you choose a speed, the program will encode the multimedia file.

NOTE You must be sure to convert your file to a bandwidth that is less than your recipient's Internet connection speed. If you convert it to a higher speed, the clip won't play. You can choose from 14.4 to 28.8, 33.6, ISDN, and T1 speeds, so try to match them as best as possible.

8. Your next option is to select your transport protocol. Choose from Video Express Email Transport or regular Internet protocol. The Video Express Email Protocol is supposed to be more reliable, but your results will vary.
9. Finally, press the Send button and the message will be sent. Make sure you're connected to the Internet at this point; otherwise, transmission

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Figure 18.5 Your email program should display the attached file pointer and the file player called SETUP.EXE. In Eudora Pro, you can just double-click on the VQX pointer file to launch and view the Video Express Email message.



message, it probably means that the multimedia message was encoded for a speed greater than you can handle. Just email the sender and ask him or her to re-encode it to your bandwidth.

If you want to reply with your own Video Express Email message, press the Reply button on the player. If you have Video Express Email installed, it will load and bring up a reply message so you can send back your own multimedia message. When you've finished viewing the file, you will be asked if you want to save it for 30 days or delete it completely. Make sure you want to delete the file because you can't get it back once it's gone.

Should You Use Video Express Email?

The main problem with Video Express Email is its whole underlying framework. Basically, what you send via email is just a pointer file. Once the recipient clicks on it, it loads the player and begins to stream the file. As described earlier, other streaming Windows programs can already do this and they don't need to use an

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The Video Express Email product (described in Streaming Email), in contrast to the claimed invention, attaches one or more files to an email including a pointer file and an optional player file which starts the player file (the player file is not required to be attached to the e-mail if it has already been installed on the user's machine). The pointer file points to an audio/visual file which is streamed to the player.

There is no disclosure in Streaming Email, pages 310-313, of **associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient.** Therefore, there is at least one missing element of claim 46 with respect to "Streaming Email."

Furthermore, the structure associated with the embodiment of claim 46 is entirely different with the structure which implements the functionality of Video Express Mail. See, for example, Appellant's Figs. 1, 4, 9-11 and 12 and accompanying descriptions which clearly disclose example structures different from that implied by Streaming Email.

For at least the forgoing reasons, the rejection of claim 46 was in error and should be withdrawn. The rejection of claims 47-51, which are dependent upon claim 46, are likewise in error and should be withdrawn.

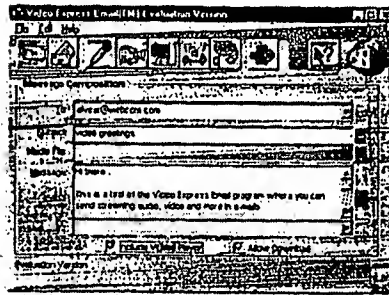
2. Claim 61

Independent claim 61 has been reproduced below:

**61. A method for providing active e-mail comprising:
generating a sender e-mail including a code segment in said e-mail to cause a self-executing, transient code segment to automatically download over a network and execute within a context of said e-mail upon an opening of said e-mail; and
sending said e-mail to a recipient.**

The Examiner rejects this claim as anticipated by Streaming Email by referring to page 309, reproduced below:

Figure 18.3 With the Video Express Email program you can load or record your own streaming audio and video messages. It has an interface that resembles an email program.



Perhaps the best way to experience Video Express Email is to view files that are sent to you. Visit ImageMind's website to send yourself some mail; you can choose from audio, video, or slide shows. Just enter your name, email address, and Internet connection speed and you will be sent a file via email. If this is your first time using Video Express Email, check the option to receive the player, too. In a few minutes, you will receive the test email. Simply use any email program to open it, install the player, and then view the audio or video message.

Video Express Email can use ASF, WAV, AVI, and QuickTime files. You can also choose to stream a PowerPoint presentation.

Video Express Email is available for Windows95 and NT only. (Macintosh versions are forthcoming, says the company.) Pricing is rather peculiar; it is based on a subscription basis that starts at \$5 a month for unlimited messages. Purchasing the Video Express Email program to create files costs an additional \$59.99. ImageMind also keeps a directory of Video Express Email users so you can exchange messages with other users.

Sending Messages with Video Express Email

Working with Video Express Email is like using a regular email program. Just enter the recipient's email address, any text message, and then select the

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There is no disclosure in "Streaming Video" on page 309 of **generating a sender e-mail including a code segment in said e-mail to cause a self-executing, transient code segment to automatically download over a network and execute within a context of said e-mail upon an opening of said e-mail**. Clearly, at least one limitation of claim 61 is not disclosed in, or suggested by, "Streaming Email." This rejection is clearly in error and should be reversed.

3. Claim 62

Independent claim 62 has been reproduced below:

62. An e-mail server comprising a computer configured to receive e-mail text from a sender, to associate said e-mail text with a code segment and to send said code segment to a recipient in a body of an e-mail.

The Examiner rejects this claim as being anticipated by Streaming Email by referring to page 309, as set forth above. There is nothing in Streaming Email on page 309 which teaches **an e-mail server comprising a computer configured to receive e-mail text from a sender, to associate said e-mail text with a code segment and to send said code segment to a recipient in a body of an e-mail.** Clearly, at least one limitation of claim 62 is not disclosed in, or suggested by, "Streaming Email." This rejection is clearly in error and should be reversed.

4. Claim 63

Independent claim 63 has been reproduced below:

63. A computer program embodied on computer-readable media for providing active e-mail comprising:
software segments receiving e-mail text from a sender;
software segments associating said e-mail text with a code segment; and
software segments sending said code segment to a recipient in a body of an e-mail.

The Examiner rejects this claim as anticipated by Streaming Email, again by referring to page 309, as set forth above. There is nothing in Streaming Email which teaches **software segments receiving e-mail text from a sender; software segments associating said e-mail text with a code segment; and software segments sending said code segment to a recipient in a body of an e-mail.** Clearly, at least one limitation of claim 63 is not disclosed in, or suggested by, "Streaming Email." This rejection is clearly in error and should be reversed.

5. Claim 64

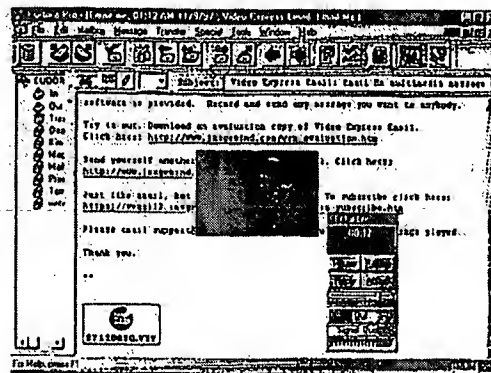
Independent claim 64 has been reproduced below:

64. A method for providing e-mail comprising:
providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and
streaming said audio and/or video file to said recipient

computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured.

The Examiner rejects this claim as anticipated by Streaming Email, by referring to pages 313 and 314. Page 313 was reproduced above, and page 314 is reproduced below:

Figure 28.6 The miniplayer launches and plays the movie back for you. If you receive an audio image, you just see an animated speaker graphic.



external email program to send streaming messages; you can send any pointer file via your regular email program. For example, with NetShow you simply create your file, upload it to the server, then create the ASX pointer file and attach it to your email. For those who don't have NetShow installed, you can include a link to Microsoft's site to download the player. So, in effect, NetShow and Video Express Email work the same way. The main difference is that with Video Express Email, you don't need to have your own server to upload files.

The other problem is that you don't have much control over the stream. There is no volume control, no Seek bar and, worst-of all, you can't save the multimedia files to your hard disk after you finish watching the stream. The sender must attach the actual compressed file to the email message instead. In this case, you already lose out on the benefits of streaming mail if you attach the file.

The main advantage Video Express Email has over the other programs in this chapter is that it does do honest-to-goodness streaming of AVI, QuickTime, ASF, and WAV files. This means you can send very large files without worrying about download times. You also don't need to open your browser to view streaming files.

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There is nothing in Streaming Email on pages 313 or 314 which teaches providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and streaming said audio and/or video file to said recipient computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured. Clearly, at least one limitation of claim 64 is not disclosed in, or suggested by, "Streaming Email." This rejection is clearly in error and should be reversed.

6. Claim 65

Independent claim 65 has been reproduced below:

65. A computer program embodied on computer-readable media for providing e-mail comprising:

software segments providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and

software segments streaming said audio and/or video file to said recipient computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured.

There is nothing in Streaming Email on pages 313 or 314 (reproduced above) which teaches **providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and streaming said audio and/or video file to said recipient computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured.** Clearly, at least one limitation of claim 65 is not disclosed in, or suggested by, “Streaming Email.” This rejection is clearly in error and should be reversed.

B. The rejection under 35 U.S.C. 102(e) of claims 84-86 as being anticipated by U.S. Patent No. 6,223,213 of Cleron et al. of is in error and should be reversed.

1. Claim 84

Independent claim 84 has been reproduced below:

**84. A method for enhancing an e-mail comprising:
enhancing an e-mail with an HTML code segment; and
reviewing the enhancement of said e-mail by executing said HTML code segment prior to sending said e-mail.**

The Examiner cites Cleron col. 6, line 63 to col. 7, line 55, reproduced below:

At step 200, the user activates the link to the email page 110. In response, the browser sends a request over to the host email service 36, which generates and serves the email page 110 (step 202). The page is written in markup language, such as HTML. The browser renders the email page 110 as

and

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illustrated in FIG. 5 (step 204). At this point, the user can optionally enter text to write an email message.

At step 206, the user activates either the "Recording" link 120 or the "Photo" link 122. Activation of link 120 causes the audio capture panel 130 to appear over the email page 110, as shown in FIG. 6. Activation of link 122 causes the video capture panel 150 to appear over the email page 110, as shown in FIG. 7.

At step 208, the user employs the capture panels 130 or 150 to capture an audio or video clip. The user clicks the "Record" or "Freeze" buttons in the respective panels to record the audio or video clip. These clips are stored in storage 34 (step 210).

After the user has captured the desired audio or video clip, the user adds the clip to the email message by clicking the "Add to Message" button 138 or 158 in the capture panels (step 212). Activation of the button causes the browser to send a request for new HTML email page that shows both the message and the attached clip. However, rather than sending across the entire video or audio clip, the browser simply inserts a token that is representative of the attached clip. The token may include such information as the name of the audio or video file, the size of the video image, and so forth. This results in a substantial savings in transmission time as the large size audio or video files are not needlessly transferred over to the host mail server merely to be transferred back again with the next page.

At step 214, the host mail service generates a response specifying a new HTML page containing the email message. The response also includes the token and indicates a location in the new page at which the audio or video data is to be rendered. The host mail service returns the response to the client.

At step 216, the browser extracts the token and retrieves the audio or video file referenced by the token from the storage 34. The browser inserts the image or sound bite at the indicated location in the HTML email page. The browser then renders the HTML email page with the image or sound bite shown attached to the bottom (step 218).

Although the addition of an audio or video clip involves a round trip request/response cycle with the host mail service, this process is hidden to the user. That is, to the user, the UI experience simply involves capturing the audio/video clip and hitting the "Add to Message" button. A new screen appears rapidly with the clip attached to the bottom of the message.

When the message is complete, the user clicks the "Send" link 126 in the email screen (step 220 in FIG. 10). In response, the browser sends the text and audio/video file over to the host mail service using a conventional POST command of HTTP. The host mail service converts the text and audio/video files to a MIME message (step 222 in FIG. 10), and forwards the MIME message to the intended recipient (step 224 in FIG. 10). The intended recipient can then render the MIME message using a browser to read and see or listen to the attached clip.

First, it should be noted that Cleron is prior art under 35 U.S.C. 102(e) only, and Appellants reserve the right to swear behind this reference at a future date. However, this is not

believed to be necessary to distinguish this claim from Cleron, who clearly teaches the sending of an audio/visual file as a MIME message. As is well known to those of skill in the art, a MIME message is an attachment for e-mails, not an HTML code segment provided in the body of an e-mail. Furthermore, there is no provision in Cleron for reviewing the enhancement to an e-mail by executing a HTML code segment enhancing the e-mail prior to sending the e-mail. This rejection is clearly in error and should be reversed.

2. Claim 85

Independent claim 85 has been reproduced below:

85. An e-mail server comprising a computer configured to enhance an e-mail with an HTML code segment and to permit the review the enhancement of said e-mail by executing said HTML code segment prior to sending said e-mail.

Again, it should be noted that Cleron is prior art under 35 U.S.C. 102(e) only, and Appellants reserve the right to swear behind this reference at a future date. However, this is not believed to be necessary to distinguish this claim from Cleron, who clearly teaches the sending of an audio/visual file as a MIME message. As is well known to those of skill in the art, a MIME message is an attachment for e-mails, not an HTML code segment. Furthermore, Cleron does not teach a server configured to enhance an e-mail with an HTML code segment and to review the enhancement by executing the HTML code segment prior to sending the e-mail. This rejection is clearly in error and should be reversed.

3. Claim 86

Independent claim 86 has been reproduced below:

**86. A computer program embodied on computer-readable media for enhancing an e-mail comprising:
software segments for enhancing an e-mail with an HTML code segment; and
software segments for reviewing the enhancement of said e-mail by executing said HTML code segment prior to sending said e-mail.**

Again, it should be noted that Cleron is prior art under 35 U.S.C. 102(e) only, and

Appellants reserve the right to swear behind this reference at a future date. However, this is not believed to be necessary to distinguish this claim from Cleron, who clearly teaches the sending of an audio/visual file as a MIME message. As is well known to those of skill in the art, a MIME message is an attachment for e-mails, not an HTML code segment. Furthermore, Cleron does not teach software segments for enhancing an e-mail with an HTML code segment and for reviewing the enhancement by executing the HTML code segment prior to sending the e-mail. This rejection is clearly in error and should be reversed.

- C. The rejection under 35 U.S.C. 103(a) of claims 1 and 33-45 as being unpatentable over XP-002150023 ("Streaming Email") in view of Tolba et al. ("Pure Java-based Streaming MPEG Player", hereafter "Tolba") is in error and should be reversed.

1. Claim 1

Claim 1 has been reproduced below:

1. **A method for providing an audiovisual e-mail system comprising:**
providing a server connected to a network;
inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network;
associating said message with a self-executing, network downloadable programmable enhancement operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network upon the opening of said e-mail and to display said audiovisual enhancement within said e-mail in conjunction with said message without the requirement of a previously installed viewer; and
sending said e-mail over said network to said at least one recipient.

It should be noted that Tolba is prior art under 35 U.S.C. 102(a), and Appellants reserve the right to swear behind this reference at a future date. However, it is not necessary to do so at this time.

As noted previously, Streaming Email teaches an attachment or "pointer" and requires the pre-installation of a viewer. Tolba teaches that an MPEG player may be written in Java, which can be implemented as an applet. Appellants respectfully submit that it is not

proper to combine Streaming Email with Tolba and, even if the references were so combined, that they still do not teach or suggest all of the elements of claim 1.

Streaming Email requires that a viewer program be previously installed on a user's computer system.¹ This is directly opposed to the limitation of claim 1 which indicates that the audiovisual enhancement can be viewed "without the requirement of a previously installed viewer." The natural combination of Streaming Email and Tolba is, therefore, having a viewer written in Java provided as an attachment to an e-mail. This clearly does not meet the "without the requirement of a previously installed viewer" limitation of claim 1.

Even if, *arguendo*, a person combining Streaming Email and Tolba decided to provide the view as a Java applet, they still are missing limitations of claim 1. For example, they do not show the inputting of a message and an audiovisual enhancement at a server to be sent as an e-mail, nor associating the message with a self-executing, network downloadable programmable enhancement. They further do not show the automatic display of the audiovisual enhancement and the associated message with the opening of the e-mail. These limitations simply cannot be found in either Streaming Email or Tolba.

Appellants respectfully submit that the Examiner is engaging in impermissible hindsight by combining the very prior art (Streaming Email) that Appellants improved upon with a partial instrumentality of their improvement (an applet), even though Streaming Email would teach away from such a combination. Furthermore, the Examiner has not shown all of the elements of the example embodiment of claim 1. The rejections of independent claim 1, and claims 33-39 which are dependent thereupon, are therefore clearly in error and should be withdrawn.

2. Claim 40

¹ "The main problem with this way of sending streaming e-mail is that sometimes the recipient doesn't have the proper player installed. How can we overcome this problem? The streaming email program described in this chapter [Video Express Email] overcomes this dilemma in two ways: by providing a built-in player that is included in the file or attaching a small player that must be installed (just once) before playing files." Streaming Email, page 305.

40. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:
a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network; and
a code segment associating said message with a self-executing, network downloadable code segment operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement within said e-mail in conjunction with said message upon the selection of said message by said at least one recipient without the requirement of a previously installed viewer.

It should be noted again that Tolba is prior art under 35 U.S.C. 102(a), and Appellants reserve the right to swear behind this reference at a future date.

As noted previously above, Streaming Email teaches an attachment or "pointer" and requires the pre-installation of a viewer. Tolba teaches that an MPEG player may be written in Java, which can be implemented as an applet. Appellants respectfully submit that it is not proper to combine Streaming Email with Tolba and, even if the references were so combined, that they still do not teach or suggest all of the elements of claim 40.

Streaming Email requires that a viewer program is previously installed on a user's computer system, as noted above. This is directly opposed to the limitation of claim 40 which indicates that the audiovisual enhancement can be viewed "without the requirement of a previously installed viewer." The natural combination of Streaming Email and Tolba is, therefore, having a viewer written in Java provided as an attachment to an e-mail. This clearly does not meet the "without the requirement of a previously installed viewer" limitation of claim 40.

Even if, *arguendo*, a person combining Streaming Email and Tolba decided to provide the view as a Java applet, they still are missing limitations of claim 40. For example, they do not show a code segment associating a message with a self-executing network downloadable code segment operative to automatically stream an audiovisual enhancement. They further do not show the automatic display of the audiovisual enhancement and the

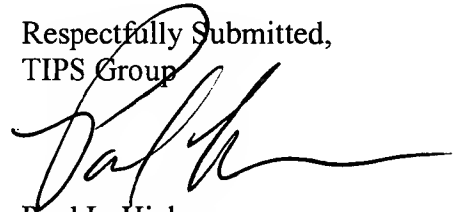
associated message with the opening of the e-mail without the requirement of a previously installed viewer. These limitations simply cannot be found in either Streaming Email or Tolba.

Appellants respectfully submit that the Examiner is engaging in impermissible hindsight by combining the very prior art (Streaming Email) that Appellants improved upon with a partial instrumentality of their improvement (an applet), even though Streaming Email would teach away from such a combination. Furthermore, the Examiner has not shown all of the elements of the example embodiment of claim 40. The rejections of independent claim 40, and claims 41-45 which are dependent thereupon, are therefore clearly in error and should be withdrawn.

Conclusion

For at least the foregoing reasons, Appellant's respectfully request that the Examiner be reversed.

Respectfully Submitted,
TIPS Group

A handwritten signature in black ink, appearing to read 'Paul L. Hickman', with a long horizontal flourish extending to the right.

Paul L. Hickman
Reg. No. 28,516

VIII. CLAIMS APPENDIX

1. A method for providing an audiovisual e-mail system comprising:
 - providing a server connected to a network;
 - inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network;
 - associating said message with a self-executing, network downloadable programmable enhancement operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network upon the opening of said e-mail and to display said audiovisual enhancement within said e-mail in conjunction with said message without the requirement of a previously installed viewer; and
 - sending said e-mail over said network to said at least one recipient.
33. A method as recited in claim 1 wherein said audiovisual enhancement includes both audio and visual components.
34. A method as recited in claim 1 wherein said audiovisual enhancement includes only an audio component.
35. A method as recited in claim 1 wherein said audiovisual enhancement includes only a visual component.
36. A method as recited in claim 1 wherein said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine.

37. A method as recited in claim 1 wherein said audiovisual enhancement is developed on a sender's machine, and is transmitted to said server over said network.

38. A method as recited in claim 37 wherein said network includes a TCP/IP network.

39. A method as recited in claim 38 wherein said network includes the Internet.

40. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network; and

a code segment associating said message with a self-executing, network downloadable code segment operative to automatically stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement within said e-mail in conjunction with said message upon the selection of said message by said at least one recipient without the requirement of a previously installed viewer.

41. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes both audio and visual components.

42. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes only an audio component.

43. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes only a visual component.

44. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine.

45. Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement is developed on a sender's machine.

46. An audiovisual e-mail system comprising:

means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender, said message to be sent as an e-mail to at least one recipient on said network; and

means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient.

47. An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes both audio and visual components.

48. An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes only an audio component.

49. An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes only a visual component.

50. An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine.

51. An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement is developed on said sender's machine.

61. A method for providing active e-mail comprising:
generating a sender e-mail including a code segment in said e-mail to cause a self-executing, transient code segment to automatically download over a network and execute within a context of said e-mail upon an opening of said e-mail; and
sending said e-mail to a recipient

62. An e-mail server comprising a computer configured to receive e-mail text from a sender, to associate said e-mail text with a code segment and to send said code segment to a recipient in a body of an e-mail.

63. A computer program embodied on computer-readable media for providing active e-mail comprising:
software segments receiving e-mail text from a sender;
software segments associating said e-mail text with a code segment; and
software segments sending said code segment to a recipient in a body of an e-mail.

64. A method for providing e-mail comprising:

providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and

streaming said audio and/or video file to said recipient computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured.

65. A computer program embodied on computer-readable media for providing e-mail comprising:

software segments providing a link between an open e-mail on a recipient computer and a stored audio and/or video file not on said recipient computer; and

software segments streaming said audio and/or video file to said recipient computer for display within said open e-mail in such a manner that other content of said e-mail which is intended to be viewed is not visually obscured.

84. A method for enhancing an e-mail comprising:
enhancing an e-mail with an HTML code segment; and
reviewing the enhancement of said e-mail by executing said HTML code segment prior to sending said e-mail.

85. An e-mail server comprising a computer configured to enhance an e-mail with an HTML code segment and to permit the review the enhancement of said e-mail by executing said HTML code segment prior to sending said e-mail.

86. A computer program embodied on computer-readable media for enhancing an e-mail comprising:

software segments for enhancing an e-mail with an HTML code segment; and

software segments for reviewing the enhancement of said e-mail by executing said

HTML code segment prior to sending said e-mail.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE